

### **REMARKS**

Claims 1-22 are currently pending in the application. The Examiner has withdrawn claims 6-13, 17, and 18 from consideration as being drawn to a non-elected invention. By this amendment, claims 1 and 21 are amended for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided at lines 12-15 of page 4 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

#### ***Information Disclosure Statement***

Applicant appreciates the Examiner's consideration of the Information Disclosure Statement filed on November 13, 2006, and note the Examiner has lined through the non-English language documents on the PTO-1449 form as failing to comply with 37 CFR 1.98. Applicant's representative does not possess English language translations of these documents, but respectfully submits that the relevance of these documents is apparent from the figures and drawings shown by these documents. Accordingly, Applicant respectfully requests the Examiner to consider the previously lined-through documents by examining the figures and drawings shown by these documents, and indicate such consideration by returning a signed and initialed copy of the PTO-1449 form with the next Official communication.

#### ***Objection to Specification***

The specification is objected to for failing to provide support for the recitation "at least one paper free layer..." in claim 21. This rejection is respectfully traversed.

Applicant notes that claim 21 recites “at least one paper free layer of a transparent synthetic resin,” and submits that the specification provides support for this feature. Specifically, after describing the problems associated with using a printed paper layer that is attached to a support board, the specification discloses a support board having a decoration printed directly on the top side of the support board, wherein the decoration is covered by at least one layer of transparent synthetic resin. The specification explicitly states that “[b]y virtue of this configuration, the paper layer is eliminated” (page 3, lines 12-13) and “[t]he absence of paper layers prevents the resulting boards from warping” (page 4, lines 7-8). This description provides clear basis for the recitation “at least one paper free layer of a transparent synthetic resin” in claim 21.

Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

### ***35 U.S.C. §112 Rejection, First Paragraph***

Claims 1-5, 14-16, and 19-22 are rejected under 35 U.S.C. §112, first paragraph. The Examiner asserts that the claims are not enabled by the specification. This rejection is respectfully traversed. Although Applicant disagrees with the rejection and submits that the claimed invention, prior to the instant amendment, is enabled so that a person of ordinary skill in the art can make and use the invention without undue experimentation. Nevertheless, in order to advance prosecution, claim 1 has been amended to recite that the support board is made of one of HDF, MDF, and chipboard. This amendment addresses the Examiner’s concerns and renders the rejection moot.

Accordingly, Applicant respectfully requests that the §112, first Paragraph, rejection of claims 1-5, 14-16, and 19-22 be withdrawn.

Claims 21 and 22 are rejected under 35 U.S.C. §112, first paragraph. The Examiner appears to be of the opinion that the recitation “at least one paper free layer of a transparent synthetic resin” is not supported by the written description. Applicant respectfully disagrees. As already discussed above with respect to the objection to the specification, Applicants submit that the original disclosure provides support for this feature of claim 21.

Accordingly, Applicant respectfully requests that the §112, first paragraph, rejection of claims 21 and 22 be withdrawn.

### ***35 U.S.C. §112 Rejection, Second Paragraph***

Claims 1-5, 14-16, and 19-22 are rejected under 35 U.S.C. §112, second paragraph. The Examiner asserts that the recitation “a decoration of wood or tile” is vague and indefinite. Applicant respectfully disagrees.

According to MPEP §2173.02, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Claims 1 and 21 recite a support board having a top side, “the top side having a decoration, of a wood or tile decoration...”. Applicant submits that this subject matter is

sufficiently described in the specification such that a person skilled in the art would understand what the claimed invention is when the claims are read in light of the specification and the teachings of the prior art. For example, in describing the state of the art, the instant specification mentions a “desired decoration (parquet, woodgrain, tiles, etc.)” (page 1, lines 14-15). It is well known in the art that floor panels may be provided with a decoration to enhance the aesthetic appeal of the floor panels.

The Examiner also asserts that claims 1 and 21 are indefinite because a wood fiberboard is recited in the preamble but not in the body of the claims. Applicant respectfully disagrees. There is no requirement that every term recited in the preamble of a claim must also appear in the body of the claim, as the Examiner appears to believe. However, in any event, both claims 1 and 21 recite “A wood fiberboard, composed of a panel comprising a support board...”. The phrase “composed of” refers to the wood fiberboard, therefore necessarily making the preamble commensurate in scope with the body of the claim.

Thus, Applicant submits one ordinarily skilled in the art reviewing the original disclosure and pending claims would understand the instant invention and readily ascertain the scope of the invention. Therefore, Applicant submits the instant rejection of claims 1-5, 14-16, and 19-22 is improper.

Accordingly, Applicant respectfully requests that the §112, second paragraph, rejection of claims 1-5, 14-16, and 19-22 be withdrawn.

### ***35 U.S.C. §102(f) Rejection***

Claims 1-5, 14-16, and 19-22 are rejected under 35 U.S.C. §102(f). The Examiner asserts that the Inventor did not invent the claimed invention, but, rather, derived the claimed invention

from U.S. Patent No. 7,171,998 issued to Vogel ("Vogel"). The Examiner asserts that Vogel discloses the claimed invention, and that this makes the inventorship of the claimed subject matter unclear. This rejection is respectfully traversed.

Applicant disagrees that Vogel discloses the claimed invention. Claims 1 and 21 of the instant invention recite a decoration of wood or tile is printed onto a top side of a support board and covered by at least one layer of a transparent synthetic resin. Vogel does not disclose a support board with a top side and an underside, the top side having a decoration, of a wood or tile decoration, wherein the decoration is printed onto the top side of the support board and is covered by at least one layer of a transparent synthetic resin.

In any event, Applicant submits herewith an affidavit under 37 CFR 1.132 providing an uncontradicted unequivocal statement showing that the subject matter claimed in the instant application is the Inventor's own work. A prior art reference that is not a statutory bar may be overcome by two generally recognized methods: an affidavit under 37 CFR 1.131, or an affidavit under 37 CFR 1.132, showing that the relevant disclosure is a description of the applicant's own work. *In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 390-91 (Fed. Cir. 1983); MPEP §2137. Also, an uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982); MPEP §716.10.

Accordingly, Applicant respectfully requests that the §102(f) rejection of claims 1-5, 14-16, and 19-22 be withdrawn.

**35 U.S.C. §102(a or e) Rejection**

Claims 1-5, 14-16, and 19-22 are rejected under 35 U.S.C. §102(a or e) as being anticipated by U.S. Patent No. 6,568,148 issued to Eisermann ("Eisermann") alone or optionally taken with Vogel or U.S. Patent No. 5,882,569 issued to Maes ("Maes"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicant submits that the applied art does not show each and every feature of the claimed invention.

**Claim 1**

The present invention relates to floor panels. In non-limiting exemplary embodiments of the invention, a support board has a decoration printed onto its tops side, thereby avoiding the problems associated with printing the decoration on paper and then attaching the paper to the support board. More specifically, independent claim 1 recites a support board made of HDF, MDF, or chipboard, wherein a decoration is printed onto a top side of the support board.

Eisermann does not disclose these features. Instead, Eisermann discloses a support plate 5 made of HDF, MDF, particle board, plywood, etc. Upper face sheet 2, which is initially separate from support plate 5 (see FIG. 2), comprises a cellulose layer 7, a decorative layer 4 printed on the cellulose layer 7, and melamine resin layers 9a and 9b covering the cellulose layer 7. The upper face sheet 2 is attached to the support plate 5 by a pressing operation. Thus, it is clear that support plate 5 does not have a decoration printed onto its top surface. In fact, at least

melamine layer 9b is disposed between the top side of the support plate 5 and the decorative layer 4.

Contrary to the Examiner's assertion, layer 7 is not made of HDF. Instead, Eisermann explicitly discloses that layer 7 consists essentially of cellulose. Only support plate 5 is disclosed as made of HDF; however, support plate 5 does not have a decoration printed onto its top side. Therefore, Eisermann does not disclose a support board made of HDF, MDF, or chipboard, the support board having a decoration printed onto its top side, and cannot arguably be said to anticipate independent claim 1

Claim 21

Claim 21 recites a decoration is printed directly onto the top side of the support board and is covered by at least one paper free layer of a transparent synthetic resin, and the support board is made of one of HDF, MDF, and chipboard. As discussed above with respect to claim 1, Eisermann does not disclose a decoration printed onto the top side of a support board made of HDF, MDF, or chipboard.

Claim 21 additionally recites the decoration is printed directly onto the top side of the support board. As discussed above with respect to claim 1, Eisermann's HDF/MDF support plate 5 does not have a decoration printed directly onto its top side. Instead, in Eisermann the decoration layer 4 is applied to layer 7. A melamine layer 9b is disposed between the support plate 5 and the decoration 4. Thus, it cannot reasonably be said that Eisermann has a decoration printed directly onto the top side of a support board made of HDF, MDF, or chipboard. As such, Eisermann does not disclose this additional feature required by claim 21.

*Claims 2-5, 14-16, 19, 20, and 22*

Claims 2-5, 14-16, 19, 20, and 22 depend from an allowable base claim, and are allowable at least for the reasons discussed above with respect to claims 1 and 21. Moreover, Eisermann does not disclose the features of many of these dependent claims.

For example, regarding claim 2, Eisermann does not disclose the decoration is also printed on to the underside of the support board. Eisermann only discloses one decorative layer 4. Eisermann does not disclose a decorative layer 4 on both the top side of the support plate 5 and the bottom side of the support plate 5.

Regarding claims 4, 5, 15, and 16, Eisermann does not disclose a relief corresponding to the decoration. Eisermann makes no mention whatsoever of a relief, much less a relief corresponding to the decoration. Moreover, contrary to the Examiner's assertion, Vogel and Maes do not teach that a relief corresponding to a decoration is inherent in a pressing operation. Instead, these references merely teach that a relief may be formed using a die or stamp during a pressing operation – not that a relief is necessarily formed in all pressing operations.

Claim 19 depends from claim 1 and recites that the decoration is printed directly onto the top side of the support plate. As discussed above, Eisermann does not show this.

Accordingly, Applicant respectfully requests that the §102(a or e) rejection of claims 1-5, 14-16, and 19-22 be withdrawn.

***35 U.S.C. §102(e) Rejection***

Claims 1, 2, 19, and 21 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,617,009 issued to Chen (“Chen ‘009”), or U.S. Patent No. 6,986,934 issued to Chen



("Chen '934"), or U.S. Patent No. 7,169,460 issued to Chen ("Chen '460"). This rejection is respectfully traversed.

As discussed above, independent claims 1 and 21 recite a support board made of HDF, MDF, or chipboard, wherein a decoration is printed onto a top side of the support board.

None of the three Chen references (Chen '009, Chen '934, or Chen '460) discloses these features. As the Examiner notes, Chen discloses a thermoplastic plank, a design printed directly onto the top surface of the plank, and a polyurethane coating on top of the printed design. Chen does not, however, disclose a support board made of HDF, MDF, or chipboard. Instead, Chen discloses that the thermoplastic plank comprises a core made of thermoplastic material, such as polyvinyl chloride, polyvinyl acetate, styrene, polystyrene, etc. Therefore, Chen does not disclose a support board made of HDF, MDF, or chipboard, wherein a decoration is printed onto a top side of the support board, and does not anticipate claims 1 and 21, and claims 2 and 19 which depend therefrom.

Accordingly, Applicant respectfully requests that the §102(e) rejection of claims 1, 2, 19, and 21 be withdrawn.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,  
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